

Remarks

In the July 18, 2007 Office Action the July 5, 2007 restriction requirement was withdrawn, a related restriction requirement was issued, and a substantive obviousness rejection was asserted. However, the July 5, 2007 restriction requirement had already been responded to on July 13, 2007 (before the July 18, 2007 Office Action formally withdrew the July 5, 2007 restriction requirement). Hence, prior to consideration of the above proposed amendment, please first enter the July 13, 2007 amendment. In this regard, the form of markings in the above amendment are intended to be with reference to how the July 13 claims have been further changed.

In any event, Applicant hereby confirms that he has elected, without traverse, and without prejudice to the filing of a divisional, the "specie" of synthetic pyrethroid insecticides and natural pyrethrum insecticides. Claims 1-5 and 7-11, as amended above, all conform to this species. See the discussion in the July 13, 2007 amendment regarding the basis for this species.

Art Rejections

Applicant next responds to the obviousness rejection as if it had been applied against claims 1-5 and 7-11, as amended above.

As an initial matter it should be noted that all claims now include the further limitation "wherein the spray is formulated so as to be capable of resisting discoloration if stored for a period of 27 days". Paragraph [0023] of the original specification recites the important advantage of the present invention which is to provide resistance to discoloration over prolonged periods during storage, when using limonene fragrance, an anti-oxidant to protect the insecticidal active, and a corrosion inhibitor. Paragraph [0029] of the original specification specifically describes a 27 day storage test.

Turning now to each of the cited references:

(a) Hallahan (2005/0069568) does not describe using corrosion inhibitors, or the use of BHT, much less formulations that achieve resistance to discoloration during storage when a corrosion inhibitor and limonene are both present. Hence, Hallahan is believed to be of only background relevance with respect to certain subsidiary features.

Applicant also reserves the right to consider swearing behind the Hallahan reference should any further reliance be made on it. However, for now, Applicant believes Hallahan to be adequately distinguished.

(b) Harper et al. (2003/0096878) describes "laundry lists" of numerous possible ingredients of various types and functions that could be included in its formulations. However, it exemplifies no formulation where all three of BHT, a benzoate and limonene are present, or even a closely analogous specific formulation. Further, there is no discussion in Harper et al. of how to formulate to avoid discoloration if limonene is present, or even a discussion of the existence of such a discoloration concern.

Merely because a single reference provides a long "laundry list" of potential ingredients that could be selected from does not preclude the patentability of a particular combination of selections. This is particularly the case, where, as here, the lists are extreme long. See e.g. In re Kollman and Irwin, 201 U.S.P.Q. 193, 198 (C.C.P.A. 1979) (a failure to highlight among the many dozens of items disclosed leads to a finding that there was no suggestion).

In any event, the purported pertinence of the Harper et al. reference has been overcome by the comparative tests reported in the original specification of this application, and the latest amendment. BHT plus limonene (without the benzoate - Formula D) readily discolored, and the discoloration effect was even stronger in the presence of the corrosion inhibitor sodium nitrite (Formula E). Yet, resistance to discoloration was achieved when another

corrosion inhibitor, a benzoate, replaces the sodium nitrite. There is nothing to suggest this surprising result, or motivate this particular selection of three ingredients out of the thousands of potential combinations based on Harper et al.

Of course, the above amendment goes beyond just requiring that BHT, limonene, and a benzoate be present. It also requires that the formulation achieve a capability of resisting discoloration during prolonged storage. This is not suggested by Harper et al. (or the other cited references).

(c) The Office Action also purported to rely on a "GB/445813". Applicant has assumed that what was intended was GB 1,445,813 and will respond on that basis.

This British reference does not describe the use of limonene or discoloration issues relating to its use. Hence, whatever its relevance regarding subsidiary features, it does not address the above key deficiencies.

(d) The Office Action also relied on McPartland (WO 98/48625). McPartland does not describe BHT being mixed with limonene and a benzoate, much less that this would avoid discoloration issues.

Conclusion

In sum, the combination of BHT, limonene and a benzoate corrosion inhibitor, in formulations which are made resistant to discoloration, is not taught or suggested by the cited art (regardless of whether Hallahan is considered as available prior art). Hence, consideration of amended claims 1-5 and 7-11 is respectfully requested.

No additional fees are believed necessary for the entry and consideration of this amendment. If any are, please charge them to Deposit Account 10-0849.

Respectfully submitted,

STANLEY J. FLASHINSKI

Date: August 2, 2007

By: 

David J. Houser
Registration No. 29,172
S.C. Johnson & Son, Inc.
Legal Department, MS 077
1525 Howe Street
Racine, Wisconsin 53403
Telephone: (262) 260-2206